

**Remarks****I. Status**

In the Advisory Action dated July 27, 2005, the Examiner: (i) refused to enter the Amendment submitted June 7, 2005; and (ii) refused to enter the Rule 1.131 Declaration submitted June 7, 2005 ("Supplemental Declaration") because "applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary or not earlier presented. *See 37 CFR 1.116(e).*" Applicant notes that the Supplemental Declaration included the following statement under 37 CFR §1.116(e):

This Supplemental declaration is being submitted after a Final Rejection because Applicant's previous submission of the Declaration was not accepted due to alleged informalities contained therein.

*Supplemental Declaration at pg. 5.* Unfortunately, the Examiner did not provide any additional information about his refusal to enter the Supplemental Declaration. Therefore, it is unclear whether the Examiner erroneously believed that Applicant failed to include a Statement under 37 CFR §1.116(e) or whether the Examiner considered Applicant's Statement to be inadequate.

Applicant subsequently filed a Notice of Appeal on August 5, 2005 and resubmits the Supplemental Declaration herewith under the provisions of Rule 41.33, together with an expanded discussion of the timing issues.

**II. Rule 41.33(d)(1) Standard**

37 CFR §41.33(d)(1) states that an affidavit or other evidence may be filed after the date of filing an appeal, but prior to submitting the brief, if the affidavit or other evidence overcomes all rejections under appeal and with a showing of good and sufficient reason why the affidavit or other evidence was not presented earlier. Aside from the “all rejections” clause, Applicant notes that filings under Rule 41.33(d)(1) are subject to the same standard as those made under Rule 116. *69 CR 49962*. That is, Applicant is not subject to a higher 'good and sufficient reasons' standard as a result of this resubmission.

**A. Timeliness under Rule 41.33(d)(1)**

This resubmitted Supplemental Declaration is filed after the date of filing an appeal pursuant to §41.31(a)(1) through (a)(3) and prior to the date of filing a brief pursuant to §41.37. Therefore, this evidence is timely filed.

**B. The evidence overcomes all the rejections under appeal.**

Only two rejections are currently of record: (i) claims 1, 5, 6, 8, 14, 18, 19, 20, 24, 25, 26, 27, 28, and 29 are rejected under 35 U.S.C. § 102(a) as anticipated by [www.webcrawler.com](http://www.webcrawler.com) (“Webcrawler Publication”); and (ii) claims 2, 3, 4, 7, 10, 11, 12, 13, 15, 16, 17, 21, 22, and 23 are rejected under 35 U.S.C. §103(a) as unpatentable over Webcrawler in view of U.S. Patent No. 5,715,415 to Dazey et al. Applicant notes that both of these rejections rely on the

Webcrawler Publication and that the Supplemental Declaration establishes a date of invention prior to the effective date of the Webcrawler Publication. Accordingly, the evidence submitted herewith overcomes all of the rejections of record and/or under appeal.

**C. Reasons why the evidence is necessary**

The evidence is necessary at least because it removes all issues under appeal.

**D. Reasons why the evidence was not earlier presented.**

Applicant submitted its First and Supplemental Declarations to remove the Webcrawler Publication as a reference. The Patent Office first cited the Webcrawler Publication in a non-final office action dated July 15, 2004 (“1<sup>st</sup> Office Action”). Obviously, Applicant did not submit these Declarations prior to receiving the 1<sup>st</sup> Office Action because it was not aware of the Webcrawler Publication.

Applicant timely responded to the non-final, 1<sup>st</sup> Action on December 14, 2004 (“Applicant’s 1<sup>st</sup> Response”). This response included Applicant’s claim of prior invention. That is, Applicant made its claim to prior invention in Applicant’s first response to the non-final, 1<sup>st</sup> Office Action, which in turn, was the first office action to cite the Webcrawler Publication.

The Patent Office issued a second office action on March 5, 2005 (“2<sup>nd</sup> Office Action”) rejecting Applicant’s First Declaration as failing to meet the technicalities of 37 CFR §1.131.

After receiving the 2<sup>nd</sup> Office Action, Applicant promptly made the requested changes, sent a draft of the Supplemental Declaration to the Examiner, and then conducted a telephonic interview with the Examiner on April 25, 2005 to review the draft. At the request of the Examiner, Applicant made several additional changes (e.g., page numbers in the attached exhibits) and then timely filed the Supplemental Declaration on July 7, 2005. That is, Applicant timely submitted the Supplemental Declaration as part of its first opportunity to reply to the 2<sup>nd</sup> Office Action.

After being verbally informed by the Examiner that the Patent Office lost Applicant's Supplemental Declaration, Applicant sent duplicate copies of the Supplemental Declaration to the Examiner and to the Patent Office's official facsimile number on July 19 and 20, 2005. Any delay caused by these lost documents is the responsibility of the Patent Office, not Applicant. *See attached 'return receipt' postcard.*

The Patent Office issued an advisory action on July 27, 2005, which indicates that the Examiner refused to enter the Supplemental Declaration because Applicant failed to provide a statement under 37 CFR §1.116(e). *Advisory Action, pg. 2, paragraph 7.* As previously noted, Applicant's Supplemental Declaration contained the following statement under 37 CFR §1.116(e):

This Supplemental declaration is being submitted after a Final Rejection because Applicant's previous submission of the Declaration was not accepted due to alleged informalities contained therein.

*Amended Declaration at pg. 5.*

Docket No.: ROC919960172US2  
Serial No.: 10/058,360

In summary, Applicant respectfully submits that there was no delay, and certainly no unreasonable delay, in this case. The Patent Office first cited the Webcrawler Publication in a non-final office action. Applicant presented its claim to prior invention in its first response to that non-final action. Applicant then acted in good faith to respond to the Examiner's requests and submitted the Supplemental Declaration at its very next opportunity.


### **III. Conclusion**

Applicant believes the Supplemental Declaration attached hereto satisfies the requirements in MPEP 715 and that all outstanding rejections have been overcome. Accordingly, Applicant respectfully requests acceptance of its claim to priority, and prompt and favorable allowance of all claims.

If the Examiner, upon considering this amendment, thinks that a telephone interview would be helpful in expediting allowance of the present application, he/she is respectfully urged to call the Applicant's attorney at the number listed below.

Date: September 13, 2005

Respectfully submitted,

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Docket No.: ROC919960172US2  
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